

Appl. No. 09/728,556
Amdt. dated January 28, 2004
Reply to Office Action of November 5, 2003

AFTER FINAL - EXPEDITED PROCEDURE**REMARKS**

Claims 1 to 22 were pending in the application at the time of examination. Claims 1 to 4, 7 to 11, 14 to 18, 21 and 22 stand rejected as anticipated. Claims 5, 6, 12, 13, 19, and 20 stand rejected as obvious.

Claims 1 to 4, 7 to 11, 14 to 18, 21 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,937,163, hereinafter Lee.

Applicant first recites, in Claim 1, "A computer-based method of interactively generating an index page." Thus, the method is directed at generating an index page and not using a table of contents or a tab for information retrieval as taught by Lee. Applicant respectfully continues to traverse the anticipation rejection of Claim 1.

Prior to addressing the Examiner's rejection, Applicant respectfully points out the standard in the MPEP by which the Examiner is required to evaluate both Applicant's claims and the prior art reference. The MPEP requires that for an anticipation rejection

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). (Emphasis added.)

MPEP § 22131, 8th Ed., Rev. 1, p 2100-70, (Feb 2003). Thus, the MPEP requires "The identical invention must be shown. . ." in Lee.

In interpreting Claim 1 for comparison with Lee, the MPEP requires:

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Appl. No. 09/728,556
Amdt. dated January 28, 2004
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AFTER FINAL - EXPEDITED PROCEDURE

Office personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. (Emphasis in original.)

MPEP § 2106 C., 8th Ed., Rev. 1, p 2100-7, (Feb 2003).

The MPEP further requires:

Office personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that Office personnel correctly interpret each claim limitation.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. (Emphasis added.)

MPEP § 2106 C., 8th Ed., Rev. 1, p 2100-8, (Feb 2003).

Claim 1 recites a particular order and sequence of operations and elements used in those operations. Specifically,

displaying a window including a list of index page types; (Emphasis added.)

Thus, Claim 1 first recites that a window is displayed that includes "a list of index page types." The Examiner cited "(table of contents, col. 9, lines 59-67, and figs. 10-11)". Col. 9, lines 59-67 of Lee stated:

. . . One tab, designated the table of contents, includes the entire hierarchical tabular listing of URLs and HTML links organized into chapters (highest level of the hierarchy) and sections (lower levels of the

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Appl. No. 09/728,556
Amdt. dated January 26, 2004
Reply to Office Action of November 5, 2003

AFTER FINAL - EXPEDITED PROCEDURE

hierarchy). The user may scroll through the entire table of entries in the table of contents. Using a pointing device, the user may advance to the information retrieved by executing the respective URL or HTML link by selecting the displayed entry therefor in the table of contents or by selecting an image of an indexing tab with the pointing device. The hierarchical organization therefore also provides an index to the retrieved information. (Emphasis added.)

Thus, the table of contents is used to retrieve information associated with a URL or HTML link in the table of contents. This fails to teach anything concerning a list of index page types. A Table of Contents is only one of the possible index page types and so displaying a Table of Contents teaches away from the recited list. The Examiner is referred to the above teachings of the MPEP concerning claim interpretation and how the MPEP directs the Examiner to interpret "a list of index page types."

Next, Claim 1 recites:

displaying a window including a list of index line types for one index page type upon selection of said one index page type in said list of index page types;
(Emphasis added.)

Thus, as recited in the claim, a selection of one index page type in the list in the first window results in display of a window including a list of index line types for the selected index page type. As noted above, the entries on the Table of Contents cited by the Examiner are not a list of index page types but rather URL and HTML links. Second, selection of an item in the Table of Contents results in retrieval of specific information, as quoted above from Lee. The Examiner has cited no teaching that this information is "a list of index line types for one index page type" that is associated with the selected index page type.

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Appl. No. 09/728,556
Amdt. dated January 28, 2004
Reply to Office Action of November 5, 2003

AFTER FINAL - EXPEDITED PROCEDURE

Instead, the Examiner cites "list of entries, col. 9, line 51-58 and elements 120' of fig. 10)." First, the Examiner is not following the sequence of limitations as recited in Claim 1 and is not following the operation of Lee, as described by Lee.

Second, the Examiner has cited two different levels of the reference as teaching a single element in Applicant's claim, as discussed more completely below. This is a further demonstration that the Examiner's interpretation of the reference is not well founded.

The Examiner is reminded of the requirement that the reference teach exactly what is claimed. By modifying the order of Lee and rearranging the elements of Lee to read on Claim 1 the Examiner's rejection demonstrates that the anticipation rejection is not well founded.

Finally, the Examiner rejected "a list of entries" and not the specific list recited with the specific relationship to the previous element. Note that the above quotation from the MPEP requires "The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined."

Moreover, Col. 9, lines 51 to 58 of Lee stated:

If one of these home page HTML links is executed, the display monitor illustratively may display a list of entries of the URLs and HTML links in the retrieved information immediately below the entry corresponding to the executed HTML link. This second list of entries may be indented two tab stops to indicate that such HTML links are on a level of the hierarchy below the executed HTML link. (Emphasis added.)

A list of links in retrieved information fails to teach "a list of index line types," as recited by Applicant. Also, Lee is clearly describing "This manner of presentation of information for retrieval from the server node defines a hierarchy of organization from the most general to the most

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Appl. No. 09/728,556
Amdt. dated January 28, 2004
Reply to Office Action of November 5, 2003

AFTER FINAL - EXPEDITED PROCEDURE

specific." Lee at Col. 9 characterizes the section quoted by the Examiner, lines 48 to 51 as:

The entries for the retrieved URLs and HTML links on the home page are illustratively indented one tab stop to indicate that they are on a lower level of the hierarchy than the URL.

Thus, it is an indented link that is selected on the display that leads to the section cited by the Examiner. The items for element 120' are "Each book icon . . . corresponds to a distinct organization of URLs and HTML links for different topics of interest. Thus, the Examiner has cited two different hierarchical levels of Lee, a very top level that corresponds to a distinct organization, and a level that is below this very top level as teaching Applicant's claim element. Two different things cannot teach exactly what is claimed as required in the MPEP quoted above. Applicant does not recite lists in the abstract, but rather specific types of lists that have a specified relationship to each other.

The Examiner continues to use equivalent parts of Lee, elements 120 and 120' to teach two different parts of Claim 1.

This is further evidence that the anticipation rejection is not well founded. The Examiner justified continuing this part of the rejection by stating:

. . . Applicant has shown the meanings of tokens are symbols (page 2 lines 16-20 in the Specification); therefore, Lee clearly teaches each different icon or symbol characterizes an individual meaning of help user in organizing data . . .

This statement demonstrates that the Claim has not been considered as required by the MPEP. Also, at best, these comments consider tokens in the abstract and ignore the express teaching of Lee on how to use the tokens and what the tokens

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Appl. No. 09/728,556
Amdt. dated January 28, 2004
Reply to Office Action of November 5, 2003

AFTER FINAL - EXPEDITED PROCEDURE

represent. Again, the MPEP requirement is not that tokens in general are shown and could be used in a different context, but rather the reference must teach "The identical invention . . . in as complete detail as is contained in the . . . claim."

Claim 1 recites:

displaying a token string including a plurality of tokens for one index line type, upon selection of said one index line type in said list of index line types, wherein said plurality of tokens includes only tokens appropriate for said one index line type (Emphasis added.)

The Examiner has not explained how or where it is taught in Lee that the book icons cited by the Examiner are displayed "upon selection of said one index line type." The Examiner also has not explained or cited how Lee teaches that the book icons are "only tokens appropriate for said one index line type." In fact, the book icons are at the top of the hierarchy of Lee as unambiguously stated by Lee in the text cited by the Examiner and so cannot teach the express limitations recited in Claim 1. The Examiner rejection is not sufficient to support an obvious rejection because it requires a modification to Lee, let alone the pending anticipation rejection.

Only one distinction is required to overcome the anticipation rejection. Applicant has shown that at every level there are multiple reasons why Applicant's Claim 1 distinguishes over Lee. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 1.

Claims 2 to 4, and 7 depend from Claim 1 and so distinguish over the cited reference for at least the same reasons as Claim 1, which are incorporated herein by reference.

Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claims 2 to 4, and 7.

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Appl. No. 09/728,556
Amdt. dated January 28, 2004
Reply to Office Action of November 5, 2003

AFTER FINAL - EXPEDITED PROCEDURE

With respect to the anticipation rejection of Claim 8, the Examiner stated:

. . . Lee clearly discloses that the Table of Contents can be updated to reflect changes of new links or information of those links . . . therefore, if information of links are changed, the index page dialogue window (Table of Contents) of Lee will be inserted to update to reflex (Sic) changes.

With all due respect, these comments have nothing to do with Applicant's invention as recited in Claim 8. A Table of Contents fails to teach or suggest, "an insert index page dialogue window comprising: an index page type window . . . an index page title window . . . an index line type window. . . ."

Changing a Table of Contents fails to teach a window including the three recited windows and the other express limitations as discussed above for Claim 1 and incorporated herein by reference. The insert index page dialogue window provides an interface for inserting an index page and provides an explicit relationship between the elements used in doing this. Modifying an existing index page, such as a table of contents, fails to teach the exact invention recited. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 8.

Claims 9 to 11, and 14 depend from Claim 8 and so distinguish over the cited reference for at least the same reasons as Claim 8, which are incorporated herein by reference.

Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claims 9 to 11 and 14.

With respect to Claim 15, the language discussed above with respect to Claim 1 is included in Claim 15. Therefore, the comments with respect to Claim 1, which are incorporated herein by reference, are directly applicable to Claim 15.

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Appl. No. 09/728,556
Amdt. dated January 28, 2004
Reply to Office Action of November 5, 2003

AFTER FINAL - EXPEDITED PROCEDURE

Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 15.

Claims 16 to 18, and 21 depend from Claim 15 and so distinguish over the cited reference for at least the same reasons as Claim 15, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claims 16 to 18 and 21.

With respect to Claim 22, the language discussed above with respect to Claim 1 is included in Claim 22. Therefore, the comments with respect to Claim 1, which are incorporated herein by reference, are directly applicable to Claim 22. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 22.

Claims 5, 6, 12, 13, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,937,163 (Lee) in view of U.S. Patent No. 5,623,679, hereinafter Rivette.

Assuming that the combination of references is appropriate and the characterization of Rivette is correct, the information relied upon by the Examiner from the secondary reference fails to address the shortcomings of the primary reference and noted above for Claims 1, 8, and 15. Moreover, the Examiner has failed to explain how Lee would be modified to generate a bibliographic reference since Lee is concerned with presentation of links in retrieved information and has failed to show how Lee would continue to work for its intended purpose after the modification. Hence, according to the MPEP, the combination is inappropriate. Therefore, each of Claims 5, 6, 12, 13, 19 and 20 distinguishes over the combination of references. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 5, 6, 12, 13, 19, and 20.

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Appl. No. 09/728,556
Amdt. dated January 28, 2004
Reply to Office Action of November 5, 2003

AFTER FINAL - EXPEDITED PROCEDURE

Claims 1 to 22 remain in the application. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306, on the date shown below.

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Respectfully submitted,



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Page 10 of 10